

REMARKS

Applicants thank the Examiner for the interview of January 25, 2005. The remarks and amendments of this response substantially reflect those discussed at the interview. Reconsideration of the application is respectfully requested.

Claims 1-43 and 45-80 are pending. Claim 44 was cancelled. Claims 1, 7, 11, 12, 27, 33, 34, 46, 51, 52, 58, 59, 63, 64, 69, 70, 71, and 72 have been amended.

Claims 1, 27, 46, 58, 70, 71, and 72 were amended to recite elastomeric composition. Support for this amendment may be found, for example, on page 22, paragraph [0062]. Claims 1, 27, 46, 58, 70, 71, and 72 were also amended to recite wherein the elastomeric composition comprises 80 or more parts per hundred rubber of the carbon black. Support for this amendment may be found, for example, in the inventive examples in Table 9 on page 50.

Claims 7, 11, 12, 33, 34, 51, 52, 59, 63, 64, 69, and 72 were amended to recite proper Markush format.

The title of the application on page 1 was amended to recite ELASTOMERIC COMPOSITION PRODUCED USING POLYBUTENE PROCESSING AIDS. Support for this amendment may be found, for example, on page 19, paragraph [0056].

Thus, Applicants respectfully submit that the above amendments add no new matter.

SPECIFICATION

The title of the invention was amended to be indicative of the invention.

CLAIM OBJECTIONS

Claim 44 was objected to for the reasons stated on page 2 of the Action. Claim 44 has been cancelled. Applicants respectfully request that the rejection be withdrawn.

35 USC § 112

Claims 7, 11, 12, 33, 34, 35, 51, 52, 59, 63, 64, 69, and 72 were rejected under 35 USC § 112, second paragraph, for the reasons stated on pages 2-3 of the Action. Claims 7, 11, 12, 33, 34, 51, 52, 59, 63, 64, 69, and 72 have been amended as suggested by the Examiner. Claim 35 was not amended. Applicants respectfully request the rejections be withdrawn.

35 USC § 102

Claims 1-25, 27-35, 38-43, and 46-80 were rejected under 35 USC § 102(b) as being anticipated by WO 02/48257 to Dias *et al.* (herein "Dias") for the reasons stated on pages 3-5 of the Action. Applicants have amended independent claims 1, 27, 46, 58, 70, 71, and 72 to recite wherein the elastomeric composition comprises 80 or more parts per hundred rubber of the carbon black. Applicants respectfully submit that, although Dias discloses some overlapping ranges of carbon black (*See e.g.*, Dias at page 21, lines 10-15, *but compare with* page 26, lines 22-26, and, page 27, lines 1-19), the claimed range of carbon black is not disclosed with *sufficient specificity* and would not be anticipated in light of MPEP § 2131.03 II.¹ Applicants respectfully request that the rejection be withdrawn.

35 USC § 103

Claims 26, 36, 37, 44, and 45 were rejected under 35 USC § 103(a) as being unpatentable over Dias in view of EP 0 376 558 to Kay *et al.* (herein "Kay") for the reasons stated on pages 5-6 of the Action. Applicants respectfully disagree. Kay neither discloses the claimed range of carbon black nor does either reference provide any guidance on the particular carbon black that should be employed. Thus, Applicants respectfully submit that the subject claims would not be obvious over Dias in view of Kay.

¹ Applicants also point-out that Dias does not disclose specific examples of the Applicants' claimed range. *See e.g.*, Table 3, page 37; Table 4, page 38; Table 5, page 39; Table 11, page 46; Table 12, page 47; and Table 14, page 50.

DOUBLE PATENTING**Double Patenting I**

Claims 14 and 39 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,626,219 in view of Dias for the reasons stated on pages 6-7 of the Action. Applicants submit herewith a terminal disclaimer for the primary reference of this rejection and respectfully request the rejection be withdrawn.

The Action also stated that claims 14 and 39 were not patentably distinct from claim 1 of U.S. Patent No. 6,626,219 (U.S. Serial No. 09/736,524) for the reasons stated on page 7. Applicants submit herewith a copy of the assignment of U.S. Patent No. 6,626,219 showing that the inventions were commonly owned at the time the invention of this application was made and respectfully request that the rejection be withdrawn.

Claims 14 and 39 were rejected under 35 USC § 103(a) as being obvious over U.S. Patent No. 6,626,219 (U.S. Serial No. 09/736,524) in view of Dias for the reasons stated on page 8 of the Action. Applicants respectfully submit that the assignment referenced above for the primary reference of this rejection shows that the subject matter of the reference and the claimed invention were, at the time the invention was made, was owned by the same person or subject to an obligation of assignment to the same person. As such, Applicants respectfully request that the rejection be withdrawn.

Double Patenting II

Claims 1-4, 7, 9, 11, 22-24, 58, 61, and 63 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over certain claims of copending Application No. 10/398,301 (U.S. Patent Application Publication No. 2004/0087704) in view of Dias for the reasons stated on page 9 of the Action. Applicants submit herewith a terminal disclaimer for the primary reference of this rejection and respectfully request the rejection be withdrawn.

USSN: 10/633,001

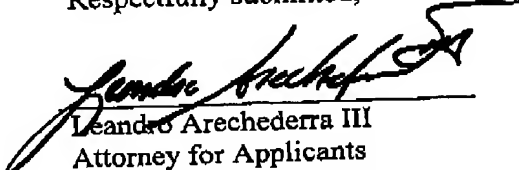
16

I:\BPCV\AWP\Prosecution\EMCC Prosecution\2003\2003B079\US\2003B079-US-2005\FEB14-Response to 1st OA.doc

Applicants respectfully request that all rejections be withdrawn and respectfully solicit a prompt notice of allowance. Applicants invite the Examiner to telephone the undersigned attorney if there are any issues outstanding which have not been presented to the Examiner's satisfaction.

Respectfully submitted,

2/14/05
Date


Leandro Arechederra III
Attorney for Applicants
Registration No. 52,457

ExxonMobil Chemical Co.
Law Technology
P.O. Box 2149
Baytown, Texas 77522-2149
Phone: 281-834-2173
Fax: 281-834-2495

USSN: 10/633,001

17

I:\WPCLAW\Prosecution\FMCC Prosecution\2003\2003B079\US\2003B079-US-2005FER14-Response to 1st OA.doc